

REMARKS

Claims 1-15, 17-20, 35-50, 52-56 and 58-62 are pending in the present application.

Claims 14, 15, 46-50, 53, 54, 59 and 60 are objected to as depending from rejected base claims.

Claims 1-13, 17-20, 35-45, 47-50, 52, 54-56, 58 and 60-62 stand rejected. Applicant has amended claims 1, 12, 35, 52, 58 and 62 and Applicant believes that the present application is now in condition for allowance, which prompt and favorable action is respectfully requested. No new matter has been added.

35 U.S.C. § 102(e) Anticipation Rejections

Claims 1-8, 12, 13, 35-39, 41, 43-45, 52, 58 and 62 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,447,287 to Parantainen ("Parantainen"). Applicant respectfully traverses this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant submits that Parantainen does not and cannot anticipate under 35 U.S.C. § 102 the presently claimed invention of independent claims 1, 12, 35, 52, 58 and 62 because Parantainen does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claims.

Regarding independent claims 1, 12, 35, 52, 58 and 62, Applicant's independent claims 1, 12, 35, 52, 58 and 62 recite the "*determining/determination*" of issuing a grant in response to a request for grant, *is performed within the base station* "*wherein the base station is a serving base station*" while Parantainen discloses determination is performed *outside of the base station* and clearly *not at a serving base station*. Specifically, Applicant's independent claims recite, *inter alia*:

Claim 1: A base station comprising ... a processing subsystem configured ... to make a determination whether or not to issue a grant to the mobile station *in response to the request* for grant ... *wherein the base station is a serving base station*.

Claims 12, 52, 58 and 62: ... to generate a request for transmission to a base station in a layer for determining at the base station whether or not to issue a grant to the mobile station in response to the request for grant ... wherein the base station is a serving base station.

Claim 35: A method for a base station comprising ... determining at the base station whether to issue a grant to the mobile station in response to the request for grant ... wherein the base station is a serving base station.

Clearly Applicant claims the determination in response to a request for grant occurs within the base station "wherein the base station is a serving base station" and not external to the base station as disclosed in Parantainen. Applicant respectfully points out that the allegations relating to Parantainen in the Office Action do not correspond with Applicant's claims. The Office Action clearly cites to Parantainen which discloses the determination occurring outside the base station. Furthermore, the Office Action takes contradictory positions with regard to the disclosure in Parantainen. In one instance the Office Action (1) attempts to include the PCU as part of the Base Station *Subsystem* (which not a base station itself) and then (2) attempts to take the position, at least with respect to Applicant's claim 3, that the PCU is separate from BS 102. Such a contradictory reinterpretation of the disclosure of the cited reference is improper.

Specifically, Applicant claims "determining/determination" of issuing a grant in response to a request for grant, is performed within the base station. Parantainen clearly illustrates in FIG. 1 that base station BS 102 is separate from PCU 103. However, the Office Action relies upon the *shorthand* name of the system as a "Base Station or BS" in a first position that the PCU 103 is disclosed as forming a part of the base station. (Parantainen, col. 1, ln. 38). This shorthand statement in Parantainen contradicts the specific *longhand* actual disclosure which clearly identifies a "system" that includes BS 102 and PCU 103, and not a base station that include PCU 103.

Specifically, Parantainen discloses:

[T]he Packet Control Unit or **PCU which is typically a part of** the Base Station *Subsystem* or BSS; more particularly a **PCU typically operates at** the Base Station Controller or **BSC**, at the Base Transceiver Station or **BTS** (also known shortly as the Base Station or BS) (Parantainen, col. 1, lns. 34-38; emphasis added).

Clearly the Office Action attempts to create a disclosure that contradicts the specific teachings of Parantainen in at least FIG. 1. The Office Action then improperly reinterprets the disclosure by taking a second position that PCU 103 and BS 102 are separate entities.

Specifically, the Office Action then states:

Regarding claim 3, Parantainen teaches wherein the processing subsystem (*PCU 103*) is *configured* to make the determination *independently of* one or more additional base stations (*BS 102*) (QoS requests handling is done at the PCU 103 and not at the BS 102)(See Fig. 1). (Office Action, p. 4; emphasis added).

The Office Action is quick to rely upon the clear teachings of FIG. 1 to support independence of PCU 103 and BS 102 in rejecting Applicant's claim 3, but apparently overlooks such disclosure which unmistakably clarifies the statement of "known shortly as the Base Station or BS" as being a "Base Station" *system* different from BS 102 in FIG. 1.

However, in an attempt to advance prosecution on the merits, Applicant has amended independent claims 1, 12, 35, 52, 58 and 62 to recite Applicant's "base station" as being "*a serving base station*" which does not lend itself to being improperly grouped into a collective "base station" including PCU 103 and BSC 104 as alleged in the Office Action. Furthermore, Applicant respectfully maintains that Parantainen's PCU 103 wherein the alleged "mak[ing] a determination ... to issue a grant" occurs is external to Parantainen's base station BS 102 as clearly illustrated in Figure 1.

Therefore, since Parantainen does not disclose Applicant's claimed invention in as complete detail as is contained in the claims as is required for a proper anticipation rejection under 35 U.S.C. §102, Parantainen cannot anticipate, according to 35 U.S.C. §102, Applicant's invention as presently claimed. Accordingly, Applicant respectfully requests the rejections of independent claim 1 with claims 2-8 depending therefrom, amended independent claim 12 with claim 13 depending therefrom, independent claim 35 with claims 36-39, 41 and 43-45 depending therefrom, and amended independent claims 52, 58 and 62 be withdrawn.

35 U.S.C. § 103(a) Obviousness RejectionsObviousness Rejection Based on Parantainen and U.S. Pat. No. 6,836,666

Claims 9-11, 40 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parantainen in view of U.S. Patent No. 6,836,666 to Gopalakrishnan *et al.* (“Gopalakrishnan”). Applicant respectfully traverses these rejections as hereinafter set forth.

The nonobviousness of independent claim 1 precludes a rejection of claims 9-11 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests the Examiner withdraw the rejection to independent claim 1 and claims 9-11 which depend therefrom.

The nonobviousness of independent claim 35 precludes a rejection of claims 36-39, 41 and 43-45 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests the Examiner withdraw the rejection to independent claim 35 and claims 36-39, 41 and 43-45 which depend therefrom.

Obviousness Rejection Based on Parantainen and U.S. Pat. No. 7,158,504

Claims 17-20, 49, 50, 55, 56 and 61 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parantainen in view of U.S. Patent No. 7,158,504 to Kadaba *et al.* (“Kadaba”). Applicant respectfully traverses these rejections as hereinafter set forth.

The nonobviousness of independent claim 12 precludes a rejection of claims 17-20 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests the Examiner withdraw the rejection to independent claim 12 and claims 17-20 which depend therefrom.

The nonobviousness of independent claim 35 precludes a rejection of claims 49 and 50 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see*

also MPEP § 2143.03. Therefore, Applicant requests the Examiner withdraw the rejection to independent claim 35 and claims 49 and 50 which depend therefrom.

The nonobviousness of independent claim 52 precludes a rejection of claims 55 and 56 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests the Examiner withdraw the rejection to independent claim 52 and claims 55 and 56 which depend therefrom.

The nonobviousness of independent claim 58 precludes a rejection of claim 61 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests the Examiner withdraw the rejection to independent claim 58 and claim 61 which depends therefrom.

Objections to Claims 14, 46, 53 and 59/Allowable Subject Matter

Claims 14, 46, 53 and 59 stand objected to as being dependent upon rejected base claims, but are indicated to contain allowable subject matter and would be allowable if placed in appropriate independent form. Applicant acknowledges this indication with appreciation, but respectfully asserts that the claims in their present form, along with all other claims presently under consideration, are in condition for allowance.

ENTRY OF AMENDMENTS

The proposed amendments to claims 1, 12, 35, 52, 58 and 62 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicant respectfully submits that all of the pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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